

REMARKS

This responds to the Office Action dated December 31, 2007.

Claims 1, 5-6, 10-11, 15-16, 20-21, 25-26, 30-31, 35-36, 40-41, 45-46, 50-54 are amended. No claims are canceled. No claims are added. As a result, claims 1-54 are now pending in this application.

§103 Rejection of the Claims

Claims 1-54 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Harry J. Maue ("How to Control Your Company's Legal Costs") in view of Walker (U.S. Patent No. 5,970,478) and further in view of Yilek ("Interest and Late Charges: How to Charge Clients") and further in view of Landry (U.S. Patent No. 5,649,117). Applicant respectfully traverses.

Applicant cannot find in the cited portions of these references any disclosure, teaching, or suggestion of a service provider providing services to a law firm in relation to separate charges assessed for *each* of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm, as currently recited or incorporated in claims 1, 6, 11, 16, 21, 26, 31, 36, 41, 46, and 51-54. Further, Applicant cannot find in the cited portions of these references any disclosure, teaching, or suggestion of determining a separate charge prior to invoicing the client for an out-of-pocket cost incurred by a law firm, as currently recited or incorporated in claims 1, 6, 11, 16, 21, 26, 31, 36, 41, 46, and 51-54. Instead, Maue teaches that a client should limit and prohibit practices in relation to expense items incurred by a law firm, teaching away from the claims. Walker makes no mention of assessing a client a separate charge for each of a plurality of out-of-pocket costs incurred by a law firm. And although Yilek teaches a law firm charging a client interest or late charges, the reference never addresses out-of-pocket charges incurred by a law firm, assessing a client a separate charge for each of a plurality of out-of-pocket costs incurred by a law firm, or determining a separate charge prior to invoicing a client for an out-of-pocket cost incurred by the firm.

Because all elements of claims 1, 6, 11, 16, 21, 26, 31, 36, 41, 46, and 51-54 are not disclosed, taught, or suggested in the cited portions of the cited references, and because the references actually teach away from such a combination, Applicant respectfully submits that no

prima facie case of obviousness presently exists with respect to these claims. Accordingly, Applicant respectfully requests withdrawal of this basis of rejection of these claims.

With respect to dependent claims 2-5, 7-10, 12-15, 17-20, 22-25, 27-30, 32-36, 37-40, 42-45, and 47-50, Applicant respectfully submits that such claims include patentable subject matter beyond that recited in their respective base claims, and Applicant reserves the right to later present further remarks concerning such dependent claims.

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 371-2174 to facilitate prosecution of this application.


If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date 2/19/08

By



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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 19 day of February 2008.

John P. Guter-Woodell

Name

Signature

